

Claims 23-53 have been deleted and replaced with new claims 54-68. No new matter has been added as a result of these amendments.

Rejection of Claims 22-53 under 35 U.S.C. Section 101

Claims 22-53 are rejected under 35 U.S.C. Section 101 as not being supported by either a specific, substantial, credible or well-established utility. Claims 22-53 have been deleted and replaced with new claims 54-68. Applicants will now address this rejection with respect to new claims 54-68.

Applicants herewith submit a 35 U.S.C. Section 1.132 declaration of Philip M. Hemken. In his declaration, Dr. Hemken describes the quantitative analysis of the levels of PS128 in prostate cancer (CaP) and benign prostatic hyperplasia (BPH) tissues. The results demonstrate that PS128 is expressed at higher levels in CaP than in BPH. Thereupon, this declaration definitely demonstrates that PS128 is useful as a marker to identify CaP. Therefore, in view of this evidence, Applicants respectfully request that this rejection be withdrawn.

Rejection of Claims 22-53 under 35 U.S.C. Section 112, First Paragraph

Claims 22-53 are rejected under 35 U.S.C. Section 112, first paragraph for the reasons set forth in connection with the 35 U.S.C. Section 101 rejection. Claims 22-53 have been deleted. Applicants will now address this rejection with respect to new claims 54-68.

Applicants submit that in view of the arguments made above in connection with the 35 U.S.C. Section 101 rejection that this rejection should be withdrawn.

Rejection of Claims 22-28, 30, 26-38 and 40 Under 35 U.S.C. Section 112, First Paragraph

Claims 22-28, 26-38 and 40 are rejected under 35 U.S.C. Section 112, first paragraph. Specifically, the Examiner raised a new matter rejection. The Examiner argues that the previous amendment to the claims to recite nucleic acid sequences selected from the group consisting of position 4-269 of SEQ ID NO:2, positions 1-276 of SEQ ID NO:4 and positions 1-276 of SEQ ID NO:5. The Examiner states that "...the parent application does not appear to contemplate the specific fragments which are less than the whole or a specific utility for the specified fragments as now recited and thus absent support the recitation constitutes new matter." Claims 22-53 have been deleted and replaced with new claims 54-68. Applicants will now address this rejection with respect to new claims 54-68.

As recited above, the Examiner believes that the parent application does not appear to contemplate the specific fragments that are less than the whole or a specific utility for the specified fragments. Applicants vigorously disagree with this statement by the Examiner. The parent application does contemplate fragments derived from polynucleotides having a nucleotide sequence of SEQUENCE ID NO: 1, SEQUENCE ID NO: 2, SEQUENCE ID NO: 3, SEQUENCE ID NO: 4, SEQUENCE ID NO: 7, SEQUENCE ID NO: 8 and SEQUENCE ID NO: 9 (See page 4, lines 1-4, page 6, lines 1-3, page 11, lines 32-35 and page 12, lines 1-2). The inclusion in the claims of the present application of the specific positions (i.e., positions 4-269 of SEQ. ID NO:2) simply makes explicit that was inherent in the specification of the present invention. This amendment does not correct any defect in the application and should be allowed. Therefore, this rejection should be removed.

Priority

The Examiner states that Applicants' claim to priority under 35 U.S.C. Section 120 to patent application 09/838,968 is denied because Applicant does not have support for 100% identity of SEQ ID Nos. 1-5 and 12-14.

In order to receive the benefit of an earlier filing date in the United States under 35 U.S.C. Section 120, an application must meet three (3) requirements, namely (1) the application must be filed by at least one inventor named in the previously filed application; (2) must be filed before the patenting or abandonment of or termination of proceeding on the first application; and (3) the application is amended to contain a specific reference to the earlier filed application.

The present application meets each of these three (3) requirements: (1) the present application was filed by at least one inventor named in the previously filed parent application; (2) the present application was filed prior to the patenting or abandonment of the parent application; and (3) the present application was amended to contain a specific reference to parent application. Therefore, under the relevant statutory law, the present application is entitled to priority to the parent application. The fact that there may or may not be 100% support for SEQ ID NOS:1-5 and 12-14 is not relevant with respect to Applicants claim of priority. Therefore, Applicants submit that this rejection should be removed.

Rejection of Claims 26, 28-29 and 37-39 Under 35 U.S.C. Section 103(a)

Claims 26, 28-29 and 37-39 are rejected as being unpatentable over Genbank Accession No. AA631976, Genbank Accession No. N80180, Genbank Accession No. AA578209, in view of Sambrook et al., *Molecular Cloning*, 1989, 16.1-16.16.

Claims 26, 28-29 and 37-39 have been deleted and replaced with new claims 54-65. In view of the cancellation of these claims, Applicants submit that this rejection is now moot and should be withdrawn.

Claim Objections

Claim 25 is objected to under 37 C.F.R. Section 1.75(c) as being in improper dependent form for failing to further limit the subject matter of a previous claim.

Claim 25 has been deleted. Therefore, Applicants submit that this objection should be withdrawn.

Rejection of Claims 25, 28-29, 34, 38-39, 44, 48 and 52 under 35 U.S.C. Section 112, First Paragraph

The Examiner has raised a new matter rejection in connection with claims 25, 28-29, 34, 38-39, 44, 48 and 52 under 35 U.S.C. Section 112, first paragraph. Specifically, the Examiner states that the recitation “a sequence encoding at least one epitope”.

Claims 25, 28-29, 34, 38-39, 44, 48 and 52 have been deleted. Therefore, this rejection has been rendered moot and should be withdrawn.

Rejection of Claims 22-35 and 46-49 Under 35 U.S.C. Section 112, Second Paragraph

The Examiner has rejected claims 22-35 and 46-49 under 35 U.S.C. Section 112, second paragraph as being indefinite. Specifically, the Examiner has stated that “[W]hile the skilled artisan recognized a degenerate codon sequence for an amino acid, one does not readily recognize one for a nucleic acid sequence which is the subject of instant claims as directed to nucleic acid sequences. Thus, the skilled artisan cannot readily discern that which is intended to be encompassed by degenerate codon equivalents of a nucleic acid sequence as recited in the claims.” Claims 22-35 and 46-49 have been deleted and replaced with new claims 54-68. Applicants will now address this rejection with respect to new claims 54-68.

The Examiner states that the phrase “degenerate codon sequence” is indefinite. Specifically, the Examiner states that a degenerate codon sequence is recognized for an amino acid sequence not for a nucleic acid sequence. Applicants submit that the phrase “degenerate codon sequence” is appropriate for a nucleic acid sequence and not an amino acid sequence. The degeneracy of the genetic code is a concept well known to those skilled in the art and is discussed in Section 2144.09 in the *Manual of Patent Examining*

Procedure (August 2001) (“MPEP”). Specifically, the MPEP states that “there are a vast number of nucleotide sequences that might encode for a specific protein as a result of degeneracy in the genetic code (i.e, the fact that most amino acids are specified by more than one nucleotide sequence or codon).” Therefore, in view of the aforementioned arguments, Applicants submit that this rejection should be withdrawn.

Rejection of Claims Under 35 U.S.C. Section 102(b)

Claims 25, 28, 34, 38, 44, 48 and 52 are rejected under 35 U.S.C. Section 102(b) as being anticipated by GenEMBL Accession No. YSCNACT, 16 February 1996 and Lee et al., *J. Biol. Chem.*, 264(21):12339-12343. Additionally, claims 28, 34, 38 and 44 are rejected under 35 U.S.C. Section 102(b) as being anticipated by Genbank Accession Nos: T25848 and T25057. As disclosed in Matsubara et al., WO95/14772.

Claims 25, 28, 34, 38, 44, 48 and 52 have been deleted. In view of the deletion of these claims, Applicants submit that this rejection is moot and should be withdrawn.

Should the Examiner have any questions concerning the undersigned at the telephone number listed below. If any additional fees are incurred as a result of the filing of this paper, authorization is given to charge deposit account no. 01-0025.



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Respectfully submitted,
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A handwritten signature in black ink, appearing to read "P. A. Billing, Medel, et al." is placed over the text above.

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